

REMARKS

Applicants have reviewed and considered the Office Action mailed on September 15, 2003, and the references cited therewith.

Claims 1, 3-5, 9, and 12 are amended, claims 13-24 were previously unelected and therefore canceled without prejudice, and claims 25-32 are added; as a result, claims 1-12 and 25-32 are now pending in this application.

Affirmation of Election

As provisionally elected by Applicants representative, Joseph Mehrle, on September 5, 2003, Applicants elect to prosecute claims 1-12.

The claims of the non-elected invention, claims 13-24, are hereby canceled, without prejudice. However, Applicants reserve the right to later file continuations or divisions having claims directed to the non-elected inventions.

§102 Rejection of the Claims

Claims 1-2 and 6-12 were rejected under 35 USC § 102(e) as being anticipated by Ito et al. (U.S. Patent No. 6,484,093). It is fundamental that in order to sustain an anticipation rejection that each and every element in the rejected claims must be taught or disclosed in the cited reference. Here, Applicants amended claims recite data that is “compressed,” there is no teaching in Ito that suggest any aspect of data compression. Accordingly, the rejections with respect to Ito are not longer appropriate and should be withdrawn.

More specifically, Ito teaches and discloses a route guidance system that externally communicates route data to mobile devices. Ito is not concerned with compressing the data and does not teach any compression techniques whatsoever. Conversely, Applicants amended independent claims and newly added claims, clearly recite data that is “compressed” and in some instances “decompressed.” Thus, the rejections with respect to Ito are no longer appropriate and should be withdrawn.

§103 Rejection of the Claims

Claims 3-5 were rejected under 35 USC § 103(a) as being unpatentable over Ito et al. (U.S. Patent No. 6,484,093) in view of Robinson et al. (U.S. Patent No. 5,995,970). The Examiner acknowledges that Robinson is commonly assigned to Garmin, the assignee of the present application as well. Correspondingly, under normal circumstances the Robinson reference could not be cited as 103(a) prior art against Garmin the assignee of the present application.

Therefore, the Examiner has relied on an exception to the AIPA amendments to 35 U.S.C. Sec. 102(e) in which the old law with respect to 102(e) is applicable in instances where the cited reference resulted in a U.S. patent either directly or indirectly from an international patent application filed before November 29, 2000. Applicants and Assignee hereby declare that the Robinson reference was never the subject of any international filing. Thus, based on the post AIPA amendments to 35 U.S.C. Sec. 102(e) the Robinson reference is not prior art to the Applicants under 103(a) as the Examiner has asserted.

Accordingly, the rejections of claims 3-5 should be withdrawn and along with an indication that these claims are allowed because the Robinson reference is not a 103(a) prior art reference with respect to the Applicants.

Conclusion

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney (513-942-0224) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,


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By their Representatives,

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Date 12-15-03

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 15th day of December, 2003.

Candis B. Buending

Name

Signature

